

REMARKS

Claims 1-11 were pending in the present application. By virtue of this response, claims 1-11 have been canceled and new claims 12-38 have been added. Accordingly, claims 12-38 are currently under consideration.

The specification has been amended in several places, primarily to correct typographical errors and to correct chemical nomenclature. Paragraphs [0006], [0007], and [0008] are all amended to remove "hydrogen" from the group of substituents for R^9 . The specification clearly indicates that R^9 can be singly or multiply substituted on the ring with a member of the Markush group that includes hydrogen. Inclusion of hydrogen in the group R^9 definition would be a substitution of hydrogen for hydrogen, i.e. it would not be a substitution at all. Thus, the amendment is made to clarify the error, which would be evident to one skilled in the art. Paragraph [0010] is amended to provide chemical nomenclature that more clearly describes the given structures using a standard chemical name generator tool ChemdrawUltraTM. These nomenclature changes are supported by the structures given in the specific Examples 1-57 and 59 and are also reflected in the changes to the titles of these Examples. Please note that the last compound named in the list has been amended to reflect the structure of Example 59 on page 128, which mistakenly contained a name unrelated to the given structure. Further, paragraphs [0274], [0275], [0277], [0279], [0281], [0283], [0377], [0385], [0450], [0459], [0463], [0476], [0478], [0480], [0482], [0484], [0486], [0488], [0490], and [0494] are also amended to clarify the nomenclature supported by the given structures.

Paragraph [0068] and the amendments on pages 43 and 44 are to correct typographical errors. Paragraph [0069] is amended to correct an error in one of the structures given in the scheme 2. Both structures 2a and 2b designate R^2 as the substituent on the ring, where clearly these can not be the same as one is divalent (i.e. connected via a double bond) while the other is monovalent (i.e., connected via a single bond). Structure 2a is amended to designate the substituent as $R^{2'}$, which is clearly converted to R^2 by the given method. Paragraphs [0169], [0171], [0173], [0175], [0178], [0179], and [0452] are amended to replace R^2 with $R^{2'}$, reflecting the correction to scheme 2. Paragraphs [0084] and [0086] are amended to correct clear errors in the structures given in the reaction schemes. In both cases, R^9 is limited to the 4 position of the ring, as would be clear to one

skilled in the art upon reading the specification. With respect to paragraph [0084], the described reaction steps a and b provide 6c and there is no step c. The intermediate 6b is removed from the reaction scheme to reflect the reaction as described. Further, the chemistry involved in converting the ketone to an alkylidene is well known to one skilled in the art, and involves the reaction of a phosphonium salt, for example of formula $R^9P^+Ph_3Br^-$. This reagent was mistakenly represented as $R^9CH_2Br + Ph_3P$, which reacts to provide the phosphonium salt. The CH_2 group was mistakenly included in the formula, and does not agree with the scheme, since if present, it would end up between R^9 and the ring atom (i.e., resulting in R^9CH_2 and not R^9 substituent). Also, see scheme 2 in paragraph [0069], which indicates the same reaction, correctly indicating the phosphonium salt of formula $R^2PPh_3^+X^-$. Paragraph [0085] is amended to indicate the correct author of the cited reference. Paragraphs [0206] and [0208] are amended to provide the correct compound reference, as would be clear from reading the appropriate scheme. Paragraph [0256] is amended to change method H to method I, which can be clearly seen by comparing Example 12 on page 71 to the two methods indicated on page 51. Paragraphs [0073], [0171], [0175], [0179], [0218], [0232], [0242], [0270], [0290], [0298], [0313], [0321], [0327], [0398], [0414], [0423], and [0470] are amended to insert TM after Dowex. For paragraphs [0290], [0298], and [0470], DowexTM polymeric sulfonic acid H^+ is substituted for NR-50, to properly indicate the resin used. NR-50, which is a similar polymeric sulfonic acid H^+ resin, was mistakenly put into these examples but was not the actual resin use. Paragraphs [0194], [0214], [0228], [0232], [0259], [0262], [0265], [0268], [0274], [0275], [0277], [0279], [0374], [0476], [0482], and [0486] are amended to clarify the examples. These amendments clarify the specification and would be clearly understood by one skilled in the art, and therefore do not add new matter.

The newly added claims are supported as follows. Claims 12 and 21 are supported by the Examples and compounds listed in Table 1 on page 6. For example, claim 1 is further supported by Examples 17, 33, 34, 35, 36, and 55, which are claimed in dependent claims 13, 16, 17, 18, 19, and 20 respectively. Claim 21 is further supported, for example, by Examples 1, 29, 54, 25, 62, 41, 42, 45, 61, 43, 44, 47, 48, 64, 52, 53, and 49, which are claimed in dependent claims 22-38, respectively. Amendment and cancellation of certain claims is not to be construed as a dedication to

the public of any of the subject matter of the claims as previously presented. No new matter has been added.

With respect to all amendments and canceled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Rejections under 35 U.S.C. §112

Claims 1-6, and 8-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Office Action indicates that terms such as “alkyl”, “cyanoalkyl”, etc., lack enablement in that substituents have not been set forth and said terms have not been limited to any number of carbon atoms. Applicants respectfully disagree with the rejection. The specification on pages 24-29 gives definition to the terms used in the claims. For example, “alkyl” is defined in paragraph [0024] and is limited to linear saturated hydrocarbons of one to eight carbon atoms or branched saturated hydrocarbons of three to eight carbon atoms. This definition of the term “alkyl” is applied to the other definitions using the term “alkyl”, unless indicated otherwise. Thus, “alkoxy” refers to “alkyl-O-”, where alkyl is as defined in paragraph [0024]. In addition, substitutions are clearly indicated, for example “substituted alkyl” substitutions are given in paragraph [0048]. As all the terms in question, as limited by the newly added claims, are clearly defined with the substituents and number of carbon atoms set forth in the definitions, Applicants believe that the claims are fully enabled. Applicants respectfully request that this rejection be withdrawn.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that the markush group for R9 contains the term “alkoxyalkoxy” twice. As Applicant’s have canceled claim 1, this rejection is rendered moot.

Rejection under the doctrine of obviousness-type double patenting:

Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/777,455. Applicants will take appropriate action upon indication of allowable subject matter.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.342312004900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By 

John W. Tessman

Registration No.: 43,949

MORRISON & FOERSTER LLP

755 Page Mill Road

Palo Alto, California 94304

(650) 813-5786